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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,221	03/28/2002	Michael Arlt	MERCK 2042	2924
23599	7590	12/04/2003	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			BYRD, DEVON R	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/089,221	<b>Applicant(s)</b> ARLT ET AL.	
	<b>Examiner</b> Devon R Byrd	<b>Art Unit</b> 1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Aug, 19, 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

ART UNIT: 1639

## DETAILED ACTION

### *ELECTION/RESTRICTIONS*

RESTRICTION IS REQUIRED UNDER 35 U.S.C. 121 AND 372.

THIS APPLICATION CONTAINS THE FOLLOWING INVENTIONS OR GROUPS OF INVENTIONS WHICH ARE NOT SO LINKED AS TO FORM A SINGLE GENERAL INVENTIVE CONCEPT UNDER PCT RULE 13.1.

IN ACCORDANCE WITH 37 CFR 1.499, APPLICANT IS REQUIRED, IN REPLY TO THIS ACTION, TO ELECT A SINGLE INVENTION TO WHICH THE CLAIMS MUST BE RESTRICTED.

GROUP I, CLAIM(S) 1-5, DRAWN TO A METHOD FOR PRODUCING INDOLE DERIVATIVES ON A SOLID PHASE.

GROUP II, CLAIM 6, DRAWN TO A GENERIC OF CERTAIN INDOLE COMPOUNDS.

THE INVENTIONS LISTED AS GROUPS I AND II DO NOT RELATE TO A SINGLE INVENTIVE CONCEPT UNDER PCT RULE 13.1 BECAUSE UNDER RULE 13.2, THEY LACK THE SAME OR CORRESPONDING SPECIAL TECHNICAL FEATURE FOR THE REASONS THAT FOLLOW.

PCT RULE 13.2 STATES THAT UNITY OF INVENTION SHALL BE FULFILLED WHEN THERE IS A SPECIAL TECHNICAL RELATIONSHIP AMONG THOSE INVENTIONS INVOLVING ONE OR MORE OF THE SAME OR CORRESPONDING "SPECIAL TECHNICAL FEATURES". IT FURTHER DEFINES "SPECIAL TECHNICAL FEATURES" AS "THOSE TECHNICAL FEATURES THAT DEFINE A CONTRIBUTION WHICH EACH OF THE CLAIMED INVENTIONS, CLAIMED AS A WHOLE, MAKES OVER THE PRIOR ART".

IN THE INSTANT CASE, THE TECHNICAL FEATURE THAT LINKS ALL THE CLAIMS IS THE SOLID PHASE SYNTHESIS OF INDOLE COMPOUNDS. GROUPS I AND II LACK UNITY BECAUSE THIS TECHNICAL FEATURE IS KNOWN IN THE ART AS DISCLOSED BY US PATENT 5,919,947, ISSUED JULY 6, 1999. THE REFERENCE IS DESCRIBED BELOW.

ART UNIT: 1639

'947 TEACHES THE TRACELESS SOLID PHASE SYNTHESIS OF INDOLE DERIVATIVES TO AVOID THE NEED FOR EXTRANEEOUS POLAR TETHERING SUBSTITUENTS.

THEREFORE, THE TECHNICAL FEATURE LINKING THE INVENTIONS OF GROUPS I AND II DOES NOT CONSTITUTE A SPECIAL TECHNICAL FEATURE AS DEFINED BY PCT RULE 13.2, AS IT DOES NOT DEFINE A CONTRIBUTION OVER THE PRIOR ART. GROUPS I AND II ARE DIFFERENT IN THAT THE SPECIAL TECHNICAL FEATURE OF GROUP I IS DRAWN TO A METHOD FOR PRODUCING A PLURALITY OF COMPOUNDS. THE SPECIAL TECHNICAL FEATURE OF GROUP II IS DRAWN TO A PLURALITY OF COMPOUNDS.

ACCORDINGLY, GROUPS I AND II ARE NOT SO LINKED BY THE SAME OR CORRESPONDING SPECIAL TECHNICAL FEATURE AS TO FORM A SINGLE GENERAL INVENTIVE CONCEPT.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DEVON R BYRD WHOSE TELEPHONE NUMBER IS 703-305-0159. THE EXAMINER CAN NORMALLY BE REACHED ON MON-FRI 8A-5P.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, ANDREW WANG CAN BE REACHED ON 703-306-2317. THE FAX PHONE NUMBER FOR THE ORGANIZATION WHERE THIS APPLICATION OR PROCEEDING IS ASSIGNED IS 703-308-2742.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE RECEPTIONIST WHOSE TELEPHONE NUMBER IS 703-308-1235.

DB  
NOVEMBER 24, 2003

FENNETT DELCA  
BYRD, DEVON R  
